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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,963	08/10/2001	David K. Lee	F-260	6878
919 7590 05/02/2007 PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			EXAMINER JABR, FADEY S	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 05/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/927,963	Applicant(s) LEE ET AL.	
	Examiner Fadey S. Jabr	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 3 and 11-21 have been cancelled. Claims 1 and 2 have been amended. Claims 1-2 and 4-10 remain pending and are again presented for examination.

Response to Arguments

1. Applicant's arguments filed 27 February 2007 have been fully considered but they are not persuasive.
2. Applicant's arguments filed 27 February 2007 with respect 35 U.S.C. 112, second paragraph that claim 6 is not indefinite. Examiner notes that the features upon which applicant relies (i.e., electronic address) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, if the applicant intends for the address in claim 6 to be interpreted as an electronic address, the Examiner suggests to the applicant to include electronic address in the claim limitation.
3. Applicant argues that the environment in which Wheeler is disclosed is not a carrier distribution system. However, Examiner notes that Wheeler discloses, "While the system is primarily directed to interoffice mail applications, it is not limited to such applications and may be deployed as a managing and tracking system for other mail applications and environments (0031). Therefore, Wheeler teaches that his system may be used in any system mail environment, i.e. carrier distribution system.

4. Applicant argues that the instant claim changes reflect subject matter that was inherently in the original claims as all of the steps of the original claims are performed in the carrier distribution system. However, Examiner asserts that the claim changes were not inherent in the system. The Examiner notes that the teachings of Wheeler disclose that this system can be carried out in other mail applications and environments (0031).

5. Applicant argues that there is no discussion of the sender organization providing the carrier with the unique user generated tag or the carrier reading or using such user generated unique ID tag to permit an inquiry from the sender for tracking information to be answered by the carrier simply based on providing to the carrier the user generated tag. However, Examiner notes that Wheeler discloses allowing a user to log into a system and check the status of a package (0041). Wheeler also discloses the method involves entering each item to be sent into a computer system, with each of the items having a tag. The system generates and stores a record for each item and the tag for each item is utilized at selected points in the transport of the item to control the transport. The system queries the record for an item to responds to a query concerning the item from an authorized system user to determine a response to the query and provides the response to the user (0006).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claim 6**, the recitation "...the unique sender generated identifier and *supplying to the address information* about the location of the mail item" is vague and indefinite. It is unclear to the Office how the location of the mail item can be supplied to an *address*. Appropriate correction is required in the indicated claims and any subsequent claims.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler, Pub. No. US2002/0032623 A1, hereinafter referred to as Wheeler.

As per **Claims 1**, Wheeler discloses a method comprising:

- inducting the mail item into the carrier distribution system, the mail item having thereon a unique sender generated identifier (0005-0006, 0014);
- assigning a unique carrier generated identifier to the mail item during processing of the mail item in the carrier distribution system (0012, 0080, also see Claims 1 and 25);

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- associating the unique sender generated identifier with the unique carrier generated identifier during processing of the mail item in the carrier distribution system (0012, 0080);
- providing the location information to the sender in response to the request (0006).

Wheeler fails to *explicitly* disclose obtaining the unique sender generated identifier from the mail item during processing of the mail item in the carrier distribution system. However, Wheeler discloses a mechanism for entering a mail item into the system for generating and storing a record of the mail item, where this step can be conducted in any mail application and environment (0014; 0031, lines 10-13).

Further, Wheeler et al fails to *explicitly* disclose the carrier tracking the location of the mail item through the carrier distribution system using the unique carrier generated identifier; and allowing the sender to obtain location information about the mail item using the unique sender generated identifier without the sender having knowledge of the unique carrier generated identifier by receiving at the carrier distribution system a request from the sender for location information about the mail item, the request including the unique sender generated identifier but not the unique carrier generated identifier. However, Wheeler discloses tracking mail items through a mail system (0005). Wheeler also discloses a carrier having its own tags and ID codes, the record (senders mail item ID, codes, and information pertaining to the mail item) for an item is utilized in conjunction with carrier software to generate a carrier tag with a carrier ID, where the system may also utilize the records to generate reports in response to requests for such reports from selected authorized system users (0012-0013). Moreover, Wheeler discloses a fourth mechanism by which the system utilizing the record for an item to obtain a response to a

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query from an authorized system user relating to the item and provides a response to the user, wherein the mechanism looks at appropriate fields of item records (sender and carrier associated information) to respond to such queries (0014). Further, Wheeler discloses that the system is not limited to interoffice applications and may be deployed as a managing and tracking system for other mail applications and environments (0031). A carrier distribution system, which allows a user to track their mail pieces, is an old and well known mail tracking environment. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Wheeler and include using a sender generated mail item tags and ID codes along with carrier generated mail item tags and ID codes to track mail items through a shipping system, because it allows for more than one field of information of an item record when responding to tracking queries.

As per **Claim 2**, Wheeler discloses the carrier applying the unique carrier generated identifier to the mail item (0012, 0080).

As per **Claim 4**, Wheeler discloses wherein the unique sender generated identifier is in a bar code form (0038).

As per **Claim 5**, Wheeler discloses wherein the mail item has a recipient address printed thereon and the unique sender generated identifier is located on the mail item proximate the recipient address and further comprising using the unique sender generated identifier for locating the recipient address (0038, also see Figure 3).

As per Claim 6, Wheeler discloses wherein the unique sender generated identifier includes an address and further comprising the carrier obtaining the address from the unique sender generated identifier and supplying to the address information about the location of the mail item (0006, 0038).

As per Claim 7, Wheeler discloses wherein the address is one of an e-mail address, a pager number, and a facsimile machine number (0008-0009).

As per Claim 9, Wheeler discloses uniquely associating the uniquely associating the unique sender generated and unique carrier generated identifiers by storing them in a file (0006, 0012).

As per Claim 10, Wheeler fails to *explicitly* disclose reading the unique carrier generated identifier at a plurality of locations throughout the carrier distribution system, storing in the file a date stamp, a time stamp, and a location identifier each time the reading of the unique carrier generated identifier occurs, and associating in the file the date stamp, time stamp, and location identifier with the unique carrier generated identifier and the unique sender generated identifier. However, Wheeler discloses a carrier tag and ID codes being utilized in conjunction with the sender records (sender mail item tags and ID codes), where the system may utilize the records to generate reports to requests for such reports from selected authorized system users (0012). Further, the mail item status query allows for time interval matches, recipient/sender match, mail item type match, updates the record for an item as the item reaches certain points in transport,

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and other criteria match (0013-0014, also see figure 9). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Wheeler and include a variety of criteria matches for mail item status queries, because it allows the system user to make use of a collection of mail item data to retrieve status information concerning the location of the mail item.

10. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler in view of Park et al., Pub. No. US2001/0010334 A1.

As per Claim 8, Wheeler fails to disclose wherein the unique sender generated identifier includes an electronic address and additional data that uniquely identifies the mail item. However, Park et al. teaches notifying the state in which the mail item is being processed on the E-mail address of a sender, so that the sender can know the processing procedure of the mail item (0012). Further, Park et al. teaches a user registering his/her zip code and E-mail address, etc. into a postal service server in the postal office and then inputting a zip code and name of the recipient. Then, the postal service server receives them to generate information frame to be printed on 4-state barcode and a code word for error correction and then transmits the formation frame and the code word to a barcode printing system to print a customer's barcode (0020). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Wheeler and include generating information frame to be printed on 4-state barcode using all of the above data as taught by Park et al., because it provides a considerable amount of information regarding the mail item and

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sender/recipient of the mail item onto the mail item, where the information is used to sort the mail item and notify the mail customer of the status of the mail item.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fadey S Jabr
Examiner
Art Unit 3628

FSJ

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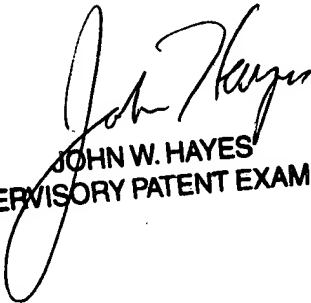
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JOHN W. HAYES
SUPERVISORY PATENT EXAMINER